

### *REMARKS*

In response to the Office Action mailed July 2, 2004, Applicants amend their application and request reconsideration. In this Amendment claim 12 is cancelled and claims 33-35 are added so that claims 1-11 and 13-35 are now pending.

### **CORRESPONDENCE ADDRESS**

During the pendency of this Application and before the mailing of the first Office Action, the correspondence address was improperly changed to attorneys who do not have a power of attorney to act on this patent application. The source of this error has not been determined. However, Applicants' representative has already filed a paper requesting the restoration of the original correspondence address. The Examiner is respectfully requested to confirm that the correct address is now entered for this patent application, the address shown at the end of this Amendment, the address corresponding customer number 23548, to ensure that all future correspondence is sent to the correct address. No other customer number has ever been authorized by the inventors for the prosecution of this patent application.

### **SPECIFICATION AMENDMENTS**

The Examiner pointed out that the specification refers to an incorrect day of filing of the parent patent application. This error, which occurred throughout the papers filed with the patent application, is regretted. The error is corrected here. In making the amendment, Applicants also add the priority claim for their provisional patent application which was not previously included in the cross-reference at the beginning of the patent application. The provisional application was actually filed on July 31, 1997, but the U.S. Patent and Trademark Office has always erroneously assigned to that provisional patent application a filing date of July 29, 1997.

### **FORMALITY REJECTIONS**

Claims 1-9 and 17-32 were rejected as indefinite with regard to certain language of claim 1 that lacked proper antecedent basis and language commonly appearing in claims 1, 17, 26, and 27. All claims have been reviewed and, where necessary, claims have been amended to overcome these rejections as to form.

Claims 1-9 and 17-32 were indicated to be allowable upon overcoming the rejection as to form. Thus, there is no further comment on those claims which should be immediately allowed.

### **PRIOR ART REJECTIONS**

Claims 13 and 16 were only objected to. In this Amendment claim 13 is rewritten in independent form and new claims 33-35 depend from that amended claim 13. Those claims 33-35 are taken from claims 14-16. Accordingly, claims 13 and 33-35 should be immediately allowed. The indicated allowability of claim 16 means that no additional comment is necessary with respect to that claim.

Claims 10-12 and 15 were rejected as anticipated by Lyons (U.S. Patent 6,282,412). This rejection is respectfully traversed with respect to the claims presented here.

Claim 10, which has been amended only as to form, is directed to a programmable frequency scanning radio receiver. As described in the patent application, this receiver receives radio frequency transmissions at respective discrete frequencies and includes a memory that stores frequency data for transmitting parties of interest located within a reception range of the radio receiver. Of course, the radio receiver is mobile so that the location can change, meaning that the respective transmitting parties of interest also change with the position of the receiver. Further, the receiver includes a database of frequency allocations and corresponding geographical location information for the frequency allocations. This database is internal to the radio receiver and is used, as explained further in the claim, in programming the frequency scanning radio receiver. The receiver also includes a processing circuit that is coupled to the memory, the receiver, and the database. This processing circuit assembles from the database, as a subset of the frequency allocations, the frequency data that is stored in the memory. This frequency data is based upon the geographical location of the frequency scanning radio receiver. With this frequency data within the memory, the processing circuit controls the receiver so only transmissions on the frequencies corresponding to the frequency data that has been stored in the memory can be received.

In order to anticipate claim 10, the receiver apparatus described by Lyons would have to include every element of the receiver described in claim 10. Lyons fails that stringent test at least with regard to the existence of a database of frequency allocations "internal to the frequency scanning radio receiver".

The receiver described in Lyons is programmed, either in an internal memory of the receiver or through the use of a memory card inserted into a card reader of the receiver, only

to receive transmissions on frequencies of transmitters that are within the receiving area of the receiver. However, the database from which the information is obtained in order to prepare the memory card employed by Lyons or to program the memory within the Lyons receiver, if a memory card is not employed, is external to the Lyons receiver. Thus, the Lyons receiver lacks the internal database of the receiver defined by claim 10.

The most pertinent description in Lyons appears in column 3 in the paragraph beginning in line 6 and in the paragraph beginning in line 57. As pointed out in the first of those paragraphs, an "application program resident in the user's own computer, or at a server of the master database, selects from the database only those stations whose service coverage at least partially overlaps the user's specified travel route. Data associated with the selected stations is then downloaded to the user, so that his/her memory card 12 is loaded or updated via the memory card interface."

"The database memory card 12 is coupled to the processor 112 via a pin connector 114 when the card is inserted in the slot 30 and the receiver 10. As mentioned, an alternate, internal database memory may instead be "hard-wired" with the processor 112. Such an internal memory would have an associated cable connector or equivalent means such as an infra-red (IR) receiver, to allow data to be entered into the memory from an outside data terminal or modem using a known data transmission protocol." (Lyons, column 3, lines 57-65.)

The two cited passages, the only pertinent part of Lyons, describes the master database as being at a remote host location as described in both the parent and grandparent of the present patent application. There is no description in Lyons of providing that master database within the receiver as in the receiver claimed in claim 10. Therefore, the rejection of claim 10 is erroneous and, upon reconsideration should be withdrawn.

In this Amendment claim 12 is combined with claim 11. In other words, amended claim 11 is essentially examined claim 12 rewritten in independent form. Both of examined claims 10 and 11 were rejected as anticipated by Lyons. The rejection is erroneous for fundamentally the same reasons already provided with respect to the rejection of claim 10. Examined and amended claim 11 is directed to a method of programming a frequency scanning radio receiver. As described in examined claim 12 and in amended claim 11, the radio receiver includes an internal database containing frequency allocations and geographical information corresponding to the frequency allocations. That internal database is employed by an internal search engine to assemble frequency data that corresponds to

geographical location information concerning the location of the radio receiver. The frequency data assembled is stored in a memory within the frequency scanning radio receiver is a subset of the information stored in the database. Lyons never describes such an internal database in his receiver nor the assembling, by a search engine within the receiver, of the subset of that information that is stored in the memory of the receiver for use in controlling tuning of the receiver. Therefore, Lyons cannot anticipate amended claim 11 or its dependent claim 15.

Claim 14 was rejected as unpatentable over Lyons, considered by itself. This rejection is respectfully traversed. Claim 14 depends from amended claim 11 and the rejection for obviousness is based upon the assertion that claim 11 is anticipated by Lyons. For the reasons already presented, there can be no such anticipation with respect to amended claim 11 so that the rejection of claim 14 cannot properly be maintained and fails with the failure of the rejection of amended claim 11, i.e., examined claim 12.

#### **CITATION OF PUBLISHED PATENT APPLICATION**

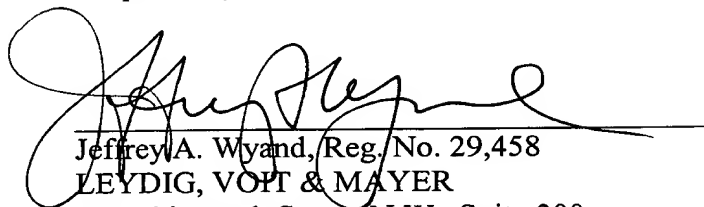
Applicants bring to the Examiner's attention the disclosure and claims of published U.S. patent application 2003/0032400 published February 13, 2003. A copy is attached. This publication is not cited in an Information Disclosure Statement because it is not prior art, having an effective filing date nearly six months after the actual filing date of the present patent application. The published patent application is assigned to an entity that either itself or through a related entity has been a licensee of the technology disclosed and claimed in the parent patent application, now U.S. Patent 6,192,223.

In re Appln. of BARNETT et al.  
Application No. 09/784,220

**SUMMARY**

The foregoing amendment places all pending claims in form for allowance which is earnestly solicited.

Respectfully submitted,



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Amendment or ROA - Regular (Revised 6/5/04)